

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Stephen Griffin et al. Confirmation No.: 1334
Serial No.: 10/729,742 Examiner: Jeffrey G. Hoekstra
Filing Date: December 5, 2003 Group Art Unit: 3736
Docket No.: 1001.1727101 Customer No.: 28075
For: GUIDE CATHETER WITH REMOVABLE SUPPORT

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 35 U.S.C. §41.41

CERTIFICATE FOR ELECTRONIC TRANSMISSION:

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 25th day of JUNE, 2008.

By



Thu H. Le-To

Dear Sir:

Appellants hereby submit this Reply Brief in response to the Examiner's Answer mailed April 30, 2008, setting a response period ending June 30, 2008.

REMARKS

The Examiner has belatedly recognized that the claimed invention is indeed entitled to analysis using the two-step process outlined in M.P.E.P. §§2181-2184 for evaluating means-plus-function limitations of claims invoking 35 U.S.C. §112, sixth paragraph. As a result, the Examiner has applied the aforementioned two-step process in the Examiner's Answer. However, the Examiner has done so incorrectly, with no basis for his assertions.

Briefly, the two-step process requires not only that the element found in the art must perform the same function specified in the claim but also that the structure of the prior art element must be found to perform the function in substantially the same way while producing substantially the same results. In attempting to apply this process, the Examiner has stated:

The "removable support means for providing column support to the elongate shaft" as cited above not only performs the same function in *substantially* the same way while producing *substantially* the same result, but is also capable of performing the same function in *substantially* the same way while producing *substantially* the same result, and in addition provides light.

Examiner's Answer, page 8

There are several problems with this statement. The Examiner's assertion that the prior art element is capable of performing equivalently to the claimed element would seem to indicate that the Examiner is not confident that the prior art element actually does perform as claimed. The fact that the prior art element provides light is meaningless to the analysis at hand, other than perhaps being an indication that the prior art element is in fact substantially different from that claimed. Moreover, the Examiner has no reasonable basis for asserting that the prior art element performs (or is capable of performing) as is required in the pending claims.

In maintaining the instant rejections, the Examiner is relying upon the signal fiber 130 of Furnish as being equivalent to the claimed "removable support means for providing column support to the elongate shaft." This is an error. Furnish describes signal fiber 130 as being a signal fiber for delivering or receiving beams of light. Furnish neither describes nor suggests, to one of ordinary skill in the art, that signal fiber 130 does or is capable of performing as a removable support means for providing column support to the elongate shaft. Furnish does not describe or suggest an element that provides the claimed function. Moreover, and as discussed

in the Appeal Brief, signal fiber 130 does not performs the function in substantially the same way while producing substantially the same results as the corresponding element disclosed in the instant specification.

The claimed invention further recites (with particular reference to claim 2) "anchoring means for securing the removable support means." The Examiner is incorrectly relying upon alignment groove 124 of Furnish as being equivalent. Alignment grooves 124 merely accommodate signal fibers 130 but cannot be considered by themselves as securing signal fibers 130. Thus, alignment grooves 124 cannot be considered as performing substantially the same function as the claimed anchoring means. It is therefore unnecessary to perform the second step of the means-plus-function evaluation.

For the reasons discussed in the Appeal Brief as well as those stated above, claims 1-7, 9, 14-15, 18 and 21 are not anticipated by Furnish under 35 U.S.C. § 102(e); claims 11-13 are patentable over Furnish in view of Rammler under 35 U.S.C. § 103(a); claims 16-17 are patentable over Furnish in view of MacDonald et al. under 35 U.S.C. § 103(a); and claims 19-20 are patentable over Furnish in view of Rammler under 35 U.S.C. § 103(a). The Examiner's rejections of claims 1-7, 9, and 11-21 should be overruled.

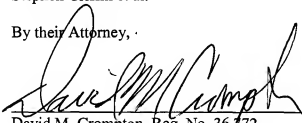
Respectfully submitted,

Stephen Griffin et al.

By their Attorney,

Date: _____

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